

REMARKS

1. Status of the claims

Claims 51-53 and 56 are now canceled. Claims 30, 44-50, 54-55, and 57-65 are currently pending.

2. Support for Amendments

Currently pending claim 30 was amended to recite “a plurality of fluorescent reporter molecules”. This amendment is supported throughout the specification, for example, on page 24, line 19 of the specification: “In another aspect, the present invention provides a method for analyzing cells comprising providing an array of locations which contain multiple cells wherein the cells contain one or more fluorescent reporter molecules...”; Original claim 1, line 2: “(a) providing an array of locations which contain multiple cells wherein the cells contain one or more fluorescent reporter molecules.”; page 17 lines 4-9; and page 33, line 11 to page 34, line 25. Other amendments are supported throughout the specification, for example, page 68, line 16 through page 72, line 12. Thus the amendments do not constitute new matter.

3. Previous Rejections under 35 U.S.C. §102(b)

The Office Action stated that rejections and/or objections not reiterated from the previous office actions are hereby withdrawn. The rejection of claim 30 under 35 U.S.C. §102(b) as anticipated by Akong et al. in the previous office action is not specifically reiterated in the current office action, and thus is withdrawn. The Applicants gratefully acknowledge withdrawal of rejections of claim 30 under 35 U.S.C. §102(b).

4. Drawings

The Applicants gratefully acknowledge the acceptance of formal drawings by the Office.

5. Restriction and/or Election Requirement

On the Office Action Summary sheet, claims 30 and 44-65 are allegedly subjected to restriction and/or election requirement. However, the Office Action did not specifically state a restriction requirement. The Applicants thus respectfully request the restriction and/or election requirement be withdrawn.

6. Claim Objection

The Office Action objected to claim 52 because the “cell” on line 1 should be in the plural form.

Claim 52 is now canceled, thus obviating the objection.

7. Provisional Obviousness-Type Double Patenting

The Office Action has provisionally rejected claims 30, 44-48, 50, 52-56, and 61-65 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24-29 and 44-54 of co-pending Application No. 09/724,376. The Applicants herewith are submitting a terminal disclaimer to obviate the rejection.

8. Claim Rejections under 35 U.S.C. §112, First Paragraph

The Action rejected claims 30 and 44-65 under 35 U.S.C. §112, first paragraph as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one of skill in the art that the inventor, at the time of the invention, had possession of the claimed invention. Specifically, the Office Action rejected the phrases “first fluorescent reporter molecule”, “second fluorescent reporter molecule”, “third fluorescent reporter molecule”, and “fourth fluorescent reporter molecule” in claims 30 and 44-65 as allegedly lacking written basis.

The Applicants respectfully traverse the rejection. The use of multiple fluorescent reporter molecules is fully supported throughout the specification as originally filed. However, in order to expedite prosecution of the instant application, Applicants have amended or canceled the claims to obviate the rejection, and thus respectfully request reconsideration and withdrawal of the rejection. The Applicants further note that these amendments in no way limit the scope of the claims.

9. Claim Rejections under 35 U.S.C. §112, Second Paragraph

The Office Action rejected claims 30 and 44-65 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Specifically, the Office Action rejected claim 30 based on the assertion that the phrase "optionally an at least fourth fluorescent reporter molecule" is vague and indefinite.

The Applicants respectfully traverse the rejection, but nonetheless have amended the claims to obviate the rejection.

10. Claim Rejections under 35 U.S.C. §103(a)

The Office Action rejected claims 30, 61, 64, and 65 under 35 U.S.C. §103(a) based on the assertion that the claims are obvious over Akong et al. (P/N 5,670,113) in view of *In re Venner*. The Office Action rejected claims 30, 44-45, 48, 51, 61, and 63-65 under 35 U.S.C. §103(a) based on the assertion that the claims are obvious over Akong et al. in view of Lee et al. (P/N 5,627,908) and *In re Venner*. The Applicants respectfully traverse the rejection. Rejection of claim 51 is made moot due to its cancellation. Claim 30, upon which all of the remaining claims ultimately depend, was amended to recite that the two or more cellular compartments of interest include at least one of the cell membrane, the endoplasmic reticulum, and the Golgi apparatus; and wherein the creating a mask of each of the two or more cellular compartments of interest comprises creating a mask of one or more of the cell membrane, the endoplasmic reticulum, and the Golgi apparatus. The combination of the cited references do not teach, suggest, or make obvious the machine readable storage medium of claim 30, nor any of the dependent claims that add further limitations.

Hence the Applicants respectfully request the Patent Office reconsider and withdraw the rejection under 35 U.S.C. § 103(a).

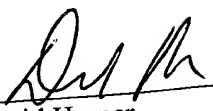
Based on the foregoing, the Applicants believe that the application is ready for allowance. If the Patent Office believes that a telephone or personal interview would expedite prosecution of the instant application, the Patent Office is invited to call the undersigned attorney at (312) 913-2106.

Date:

3/12/03

Respectfully Submitted,

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